

### **REMARKS**

Claims 1-4, 8-11, 68, 80-83 and 86-90 are pending in this application, with claims 1 and 4 being independent claims. By this amendment, Applicant has amended claims 1 and 4. Support for the claim amendments can be found in the claims as originally filed. No new matter has been added.

Applicant expressly reserves the right to pursue any subject matter canceled by this Amendment in this or one or more continuing applications.

### **Rejection under 35 U.S.C. §112**

Claims 1-4, 8-11, 68, 80-83 and 86-90 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner has maintained this rejection.

Applicant respectfully traverses. It has been contended that the claims are not enabled because allegedly “the specification provides no evidence directly correlating the presence or expression of MIVR-1 to anti-apoptotic activity” and “no evidence or information linking the claimed nucleic acids of MIVR-1 to any particular condition” and, therefore, the Examiner doubts the activity of the protein as asserted by Applicant. This is the sole reason on which this rejection is based. According to MPEP 2164.02, lack of working examples or lack of evidence that the claimed invention works as described should never be the sole reason for rejecting the claimed invention on the grounds of lack of enablement. This is an exact description of the enablement rejection asserted by the Examiner and clearly cannot be sustained.

According to MPEP 2164.01, the standard for determining whether the specification meets the enablement requirement is whether undue experimentation is required for one of ordinary skill in the art to practice the claimed invention. The Examiner has not demonstrated why the claimed invention fails to meet this requirement and has provided nothing in support of the enablement requirement other than his doubt of the activity of MIVR-1 as asserted by Applicant. Regardless of the different standards for assessing utility and enablement, the Examiner has only based the enablement rejection on the doubt of the asserted MIVR-1 activity. As has been argued previously, one of ordinary skill in the art, based on the teachings of the specification and the high level of skill in the art would easily be able to make and use the

nucleic acids of the claims. Only routine experimentation is needed. The Examiner has offered no evidence to demonstrate that this is not the case.

Reconsideration and withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. §102

Claims 1, 4, 68, 81, 88 and 89 were rejected under 35 U.S.C. §102(a) as being anticipated by Xu et al. The Examiner has maintained this rejection and clarified it.

Applicant respectfully traverses. However, in the interest of expediting prosecution of this application and without conceding the correctness of the Examiner's rejection, Applicant has amended claims 1 and 4. Therefore, Applicant believes that this rejection is now moot.

Reconsideration and withdrawal of this rejection is respectfully requested.

Rejections Under 35 U.S.C. §103

Claims 1, 4, 68, 80, 81, 88 and 89 were rejected under 35 U.S.C. §103(a) as being unpatentable over Xu et al. as applied to claims 1, 4, 68, 81 and 88 previously, and further in view of the teachings of Kumar and Buck et al. The Examiner has maintained this rejection.

Applicant respectfully traverses this rejection. However, without conceding the correctness of this rejection and only in the interest of expediting prosecution of the application, claims 1 and 4 have been amended such that the nucleic acids code for a polypeptide with anti-apoptotic activity. Accordingly, Applicant believes that this rejection is now moot.

For the record, Applicant maintains that the Examiner has failed to demonstrate that one of ordinary skill in the art would be motivated to make primers or probes to the portion of PMEPA1 that shares identity to a portion of MIVR-1. The Examiner's arguments has not demonstrated why one of ordinary skill in the art would necessarily focus on this part of the sequence of PMEPA1 to make the nucleic acids of Applicant's claims.

Reconsideration and withdrawal of this rejection is respectfully requested.

Claims 1, 4, 8-11, 80, 81 and 86-90 are rejected under 35 U.S.C. §103(a) as being unpatentable over Xu et al., as applied to claims 1, 4, 68, 80, 81, 88 and 89 above, and further in

view of the teachings of U.S. Patent No. 6,566,130 to Srivastava et al. and Lodish et al. (Molecular Cell Biology, 3<sup>rd</sup> Edition, 1995, pages 252-7).

Applicant respectfully traverses this rejection. The Examiner has not established that it would be obvious for one of ordinary skill in the art to focus on a specific portion of PMEPA1 in order to make primers and probes within the scope of the rejected claims based on the teachings of Xu et al. in view of Srivastava et al. and Lodish et al.

In addition, without conceding the correctness of this rejection and only in the interest of expediting prosecution of the application, claims 1 and 4 have been amended such that the nucleic acids code for a polypeptide with anti-apoptotic activity. Accordingly, Applicant believes that this rejection is now moot.

Reconsideration and withdrawal of this rejection is respectfully requested.

### CONCLUSION

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,



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